

REMARKS/ARGUMENTS

Status of the claims

Claims 22-27, 58, 59, and 62-69 have been rejected.

Claim 59 has been cancelled without prejudice or disclaimer in the interest of expediting the prosecution of the instant application. Claims 1-21, 28-57, 60, and 61 were previously cancelled.

Claim 22 has been amended to recite that the claimed wheat plant is selected from the group consisting of a wheat plant having ATCC Patent Deposit Designation Number PTA-4257, a wheat plant that is a recombinant or genetically engineered derivative of the plant with ATCC Patent Deposit Designation Number PTA-4257 that comprises a polynucleotide as defined in SEQ ID NO:3, a wheat plant comprising a polynucleotide as defined in SEQ ID NO:3, and derivatives and descendants thereof that comprise a polynucleotide as defined in SEQ ID NO:3. Support for the amendment of claim 22 can be found in the original claims, particularly original claims 1, 8, and 22, and in the specification.

Claims 23-25 have been amended to depend from new claim 70 instead of claim 22. New claim 70 depends from claim 22. Therefore, this amendment is purely formal in nature as claims 23-25 continue to depend indirectly from claim 22.

Claims 26, 27, and 58 have been amended to recite that the claimed plant part, plant cell, and seed, respectively, comprise a polynucleotide as defined in SEQ ID NO:3. Support for this amendment can be found in pending claim 1 and in the original claims and specification.

New claims 70-75 have been added.

New claim 70 was added to in response to the rejection of claims 23-25 for lack of antecedent basis as discussed below. New claim 70 is fully supported by the original specification and claims. Particular support can be found, for example, in original claim 1 and in the specification at paragraph 009.

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New claims 71-75 are drawn either to plants, plant parts, seeds, or plant cells of the wheat line Krichauff IMI K-42 or of hybrids derived therefrom, or to methods that involve the use of wheat line Krichauff IMI K-42. Support for these new claims can be found in the original claims and the specification, particularly in paragraphs 040, 041, 043, 091, and 091-096.

No new matter has been added by way of amendment of the claims or by the addition of the new claims.

Claims 22-27, 58, and 62-75 are pending.

Reexamination and reconsideration of the application as amended are respectfully requested in view of the following remarks.

The Rejection of the Claims under 35 U.S.C. § 112, Second Paragraph, Should Be Withdrawn

Claims 22-27, 58, 59, and 62-69 have been rejected under 35 U.S.C. § 112, second paragraph, for being indefinite. Claim 59 has been cancelled. Claims 22-27 and 58 have been amended. New claims 70-75 have been added. This rejection is respectfully traversed and should not be applied to the newly added claims.

The Office Action indicates that recitation of "the herbicide resistance characteristics of" in claims 22 and 58 renders the claims indefinite because it is unclear what the metes and bounds of "characteristics" are.

Applicants respectfully disagree this position of the Office Action because one of ordinary skill in the art in view of the instant specification would readily understand the metes and bounds of what Applicants intend by "the herbicide resistance characteristics of the plant with American Type Culture Collection (ATCC) Patent Deposit Designation Number PTA-4257". Applicants have, however, deleted this recitation from claims 22 and 58. Accordingly, this rejection is now moot.

The Office Action indicates that the recitation of "the imidazolinone herbicide" in claims 23-25 lacks proper antecedent basis. To overcome this rejection, Applicants have (1) added new

dependent claim 70, which depends from claim 22 and recites "an imidazolinone herbicide" and (2) amended claims 23-25 to depend from claim 70. In view of these amendments, there is sufficient antecedent basis for the recitation of "the imidazolinone herbicide" in claims 23-25.

The Office Action indicates that the claims 26 and 27 are indefinite because it is unclear if the claimed plant part or plant cell comprises the herbicide resistance characteristics of the wheat plant. Applicants have amended claims 26 and 27 to point out more distinctly that the claimed plant part and plant cell comprise a polynucleotide as defined in SEQ ID NO:3. As amended, claims 26 and 27 are not indefinite.

In view of the amendments and above remarks, it is submitted that the rejection of the claims under 35 U.S.C. § 112, second paragraph, should be withdrawn and not applied to the newly submitted claims.

The Rejection of the Claims under 35 U.S.C. § 112, Fourth Paragraph, Should Be Withdrawn

Claims 62-68 have been rejected under 35 U.S.C. § 112, fourth paragraph, for failing to further limit the subject matter of a previous claim upon which it depends. New claims 70-75 have been added. This rejection is respectfully traversed and should not be applied to the newly added claims.

The Office Action indicates that "[t]his rejection is made in light of the limitation 'the herbicide resistance characteristic [sic] of' at claim 22. Office Action mailed March 6, 2008, p. 3.

Applicants respectfully disagree with the position of the Office that claims 62-68 do not further limit the subject matter of a previous claim upon which it depends. In contrast to the position of the Office, each of claims 62-68 further limits the claim from which it depends. Claim 62 depends from claim 22 and recites the additional limitation: "the plant *further comprises a *Triticum aestivum* IMI nucleic acid selected from the group consisting of an Imi1 nucleic acid and an Imi2 nucleic acid.*" (emphasis added) Claim 63 depends from claim 62 and

recites the additional limitation: "the *Triticum aestivum* IMI nucleic acid encodes an IMI polypeptide comprising a mutation in a conserved amino acid sequence selected from the group consisting of a Domain A, a Domain B, a Domain C, a Domain D and a Domain E." Claim 64 depends from claim 63 and recites the additional limitation: "the conserved amino acid sequence is a Domain E." Claim 65 depends from claim 64 and recites the additional limitation: "the mutation results in a serine to asparagine substitution as compared to a wild-type AHAS protein." Finally, each of claims 66-68 depends from claim 22 and recites at least one additional limitation beyond the limitations of claim 22.

For reasons unrelated to the rejection of the claims under 35 U.S.C. § 112, fourth paragraph, Applicants have amended claim 22 to delete the recitation of "comprising the herbicide resistance characteristics of the plant with American Type Culture Collection (ATCC) Patent Deposit Designation Number PTA-4257". Accordingly, this rejection of claims 62-68 is moot.

In view of the amendments and above remarks, it is submitted that the rejection of the claims under 35 U.S.C. § 112, fourth paragraph, should be withdrawn and not applied to the newly submitted claims.

The Rejection of the Claims under 35 U.S.C. § 112, First Paragraph, Should Be Withdrawn

Claims 22-27, 58, 59, and 62-69 have been rejected under 35 U.S.C. §112, first paragraph, for failing to comply with the enablement requirement. Claim 59 has been cancelled. Claims 22-27 and 58 have been amended. New claims 70-75 have been added. This rejection is respectfully traversed and should not be applied to the newly added claims.

The Office Action indicates that the invention appears to employ novel plants but that the specification discloses neither a repeatable process to obtain the plants nor that the deposited plant seeds are publicly available. The Office Action states that the deposit requirement can be satisfied by submission of an affidavit or declaration by Applicants or a statement by an attorney of record over his or her signature and registration number indicating that all restrictions imposed

by the depositor on the availability to the public of the deposited material will be irrevocably removed upon granting of the patent.

To overcome this rejection of the claims, Applicants submit concurrently herewith a statement by an attorney of record over his or her signature and registration number indicating that all restrictions imposed by the depositor on the availability to the public of the deposited biological material will be irrevocably removed upon granting of the patent.

In view of the accompanying Statement in Support of a Biological Deposit and the above remarks, it is submitted that the rejection of the claims under 35 U.S.C. § 112, first paragraph, should be withdrawn and not applied to the newly submitted claims.

The Rejection of the Claims under 35 U.S.C. § 102(e) Should Be Withdrawn

Claims 22-27, 58, 59, and 62-69 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Pozniak *et al.*, U.S. Patent Publication No. 2004/0237134. Claim 59 has been cancelled. Claims 22-27 and 58 have been amended. New claims 70-75 have been added. This rejection is respectfully traversed and should not be applied to the newly added claims.

The Office Action indicates that Pozniak *et al.* disclose a wheat plant comprising a polynucleotide as defined in SEQ ID NO: 4 at claim 5 and asserts that this plant would inherently comprise the herbicide resistance characteristics of the deposited plant of claim 22 of the instant application as well as the plants of claims 23-25. The Office Action further asserts that this plant of Pozniak *et al.* would anticipate Applicants' claimed plant part of claim 26 and plant cell of claim 27. The Office Action further indicates that Pozniak *et al.* disclose the wheat plant further comprising an Imi1 nucleic acid at claim 10, the wheat plant comprising a nucleic acid encoding an IMI polypeptide having a serine to asparagine mutation in Domain E, the wheat plant comprising three IMI nucleic acids at claim 13, and that the wheat plant is not transgenic at claim 15.

Applicants have amended claim 22 to be directed to a wheat plant having ATCC Patent Deposit Designation Number PTA-4257 or any wheat plant comprising a polynucleotide as

defined in SEQ ID NO:3 including, but not limited to, a wheat plant that is derived or otherwise descended from the wheat plant having ATCC Patent Deposit Designation Number PTA-4257. Pozniak *et al.* does not disclose a wheat plant having ATCC Patent Deposit Designation Number PTA-4257, which Applicants also refer to as Krichauff IMI K-42. Nor does Pozniak *et al.* disclose a wheat plant comprising a polynucleotide that has a nucleotide sequence that is identical to the nucleotide sequence set forth in SEQ ID NO:3. Thus, claim 22 and dependent claims 23-27, 58, 59, and 62-70 are not anticipated by Pozniak *et al.*

New claims 71-75 are also not anticipated by Pozniak *et al.* These new claims are drawn either to plants, plant parts, seeds, or plant cells of the wheat line Krichauff IMI K-42 or of hybrids derived therefrom, or to methods that involve the use of wheat line Krichauff IMI K-42. Pozniak *et al.* does not disclose the wheat line Krichauff IMI K-42, representative seed of said line having been deposited under ATCC Patent Deposit Designation Number PTA-4257. Accordingly, the new claims are not anticipated by Pozniak *et al.*

In view of the amendments and remarks, it is submitted that the rejection of the claims under 35 U.S.C. § 102(e) should be withdrawn and not applied to the newly submitted claims.

CONCLUSION

In view of the above amendments and remarks, Applicants submit that the rejections of the claims under 35 U.S.C. §§ 102 and 112 are overcome. Applicants respectfully submit that this application is now in condition for allowance. Early notice to this effect is solicited.

If in the opinion of the Examiner a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required

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therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

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